

REMARKS

Claim 2 has been canceled. Claims 1 and 3-6 are pending. Reconsideration and allowance of the present application based on the following remarks are respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-6 were rejected under 35 U.S.C. § 103(a) over Barna (U.S. Publication No. 2002/0046277) in view of Madour (U.S. Publication No. 2003/0053431). Applicants respectfully traverse this rejection.

Claim 1 recites, in part, a method for performing a hard handoff that includes setting up a channel link passing through a target base station controller (T-BSC) associated with a target-PDSN (T-PDSN), a source base station controller (S-BSC) associated with a source-PDSN (S-PDSN), a source packet control function (S-PCF) and the S-PDSN by establishing a channel link between the S-BSC and the T-BSC via a mobile station center (MSC) in an active packet session mode. Although the Examiner previously admitted that Barna fails to teach or suggest this feature of claim 1, the Office Action, on pages 3 and 4, now alleges that Barna does teach this feature. Applicants respectfully disagree.

Barna relates to a system for monitoring and reporting accounting data based on volume and specifically address a handoff between two PDSNs. However, the handoff method disclosed in Barna is entirely different from that recited in claim 1. Specifically, the Examiner's application of Figure 2 in Barna as allegedly showing a channel link passing through a T-BSC associated with a T-PDSN, a S-BSC associated with a S-PDSN, a S-PCF and the S-PDSN is erroneous because the Examiner has misread Figure 2 of Barna. Figure 2 in Barna is a signaling diagram. As would be readily understood by a person of ordinary skill in the art, a signaling diagram shows connections between devices by lines that begin and terminate at the starting and ending devices, respectively. That is, the mere crossing of a particular device does not mean that a channel link passes through it. For example, the Examiner alleges that Figure 2 shows a channel link passing through Target BSC 64 and Source BSC 61, however, neither of these device are involved in the channel links illustrated. Therefore, BSCs 61 and 64 could be moved to the leftmost section of the diagram and no lines would cross these devices but the diagram would be unchanged. As further evidence of this, the specification when describing Figure 2 does not discuss any connection with devices 61 and 64. As previously discussed,

Madour does not remedy at least these deficiencies of Barna. Therefore, neither Barna or Madour, separately or in combination, teach or suggest the features of amended claim 1.

Accordingly, no combination of Barna and Madour teach or suggest, a method for performing a hard handoff that includes setting up a channel link passing through a target base station controller (T-BSC) associated with a target-PDSN (T-PDSN), a source base station controller (S-BSC) associated with a source-PDSN (S-PDSN), a source packet control function (S-PCF) and the S-PDSN by establishing a channel link between the S-BSC and the T-BSC via a mobile station center (MSC) in an active packet session mode, as recited in claim 1.

Further, the Office Action alleges that the combination of Barna and Madour is proper because the motivation to combine these two references is that they are in the same field. However, even though both references relate to mobile communications, Barna relates to accounting in a network, specifically during a hard-handoff and Madour relates to intra PDSN technique. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness. The Examiner is using hindsight to reconstruct Applicants' patent from prior art with no motivation provided for combining the references. The Federal Circuit has made it clear that obviousness cannot be established simply by stitching together pieces of prior art using the patent as a template. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985); see also *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 873 (Fed. Cir. 1985) (denouncing courts' tendency to depart from proper standard of nonobviousness "to the tempting but forbidden zone of hindsight."); *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."); *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.").

Respectfully, it is an incorrect application of the law for the Examiner in this case to find pieces of art from which the Examiner picks and chooses different parts to construct Applicant's invention to render it obvious. The courts have uniformly found this approach to obviousness rejections to be incorrect. Each of the cited references must provide some suggestion, motivation, or teaching for combining known components. See *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed.Cir.1994) ("When the patented invention is made by combining known components to

achieve a new system, the prior art must provide a suggestion or motivation to make such a combination.”); *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340 (Fed. Cir. 2000). The motivation provided in this case to string together the individual pieces of Barna and Madour to try to form Applicants discovery is not proper because the two references discuss entirely difference aspects of mobile communications. As a result, the Examiner has failed to provide a proper *prima facie* case of obviousness.

Claims 3-6 are believed allowable for at least the same reasons presented above with respect to claim 1 by virtue of their dependence upon claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.


Conclusion

Therefore, all objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

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